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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,749	05/31/2001	Bijan Tadayon	111325-64	5711

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,749

Applicant(s)

TADAYON ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notes

1. As to claims 1-6, the "rights management module" is interpreted as the device with both hardware (i.e. processor, controller) and software (computer executable codes) that provides the functionalities as described in page 10 of the specification.

Accordingly, the "rights management module" is not just the software codes or an abstract idea, and is considered to be statutory subject matter.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Art Unit: 3621

The independent claim 7 only recites an abstract idea of rights management, and its dependent claims 8-12 further define the field of use for the abstract idea. The recited limitations of merely managing "rights", or "conditional rights" does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user, or by use of pencil and paper. These limitations only constitute an idea of how to manage information.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claims 7-12 managing conditional rights (i.e. useful, tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 7-12 are deemed to be directed to non-statutory subject matter.

As to the independent claims 13 and 16, the claimed limitations of "a digital rights management language", "usage rights", "conditional rights", "an information storage media", and "information" are just non-functional descriptive material, and their dependent claims 14-15 and 17-22, further define the field of use for the non-functional descriptive material. In particular, the "digital rights management language" in the preamble of claim 13 does not apply to any practical applications because the "language" cannot to be categorized in any of the statutory classes (i.e. system, apparatus, article of manufacture). Accordingly, the non-functional descriptive material as claimed 13-22 is directed to non-statutory subject matter. Furthermore, the claimed "digital rights management language" and "information storage media" do not produce a

Art Unit: 3621

useful, concrete, and tangible result, thus, claims 13-22 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al., U. S. Patent 5,638,443.

As to claim 1, Stefik teaches a rights management system comprising (Fig. 14):

- a) one or more conditional rights (column 18 lines 9-26 and Fig. 14);
- b) a right management module that manages the one or more conditional rights (column 18 lines 9-26 and Fig. 14).

As to claims 2, 8 and 17, Stefik teaches the one or more conditional rights comprise one or more usage rights and one or more conditional values (column 18 lines 9-26 and column 20 lines 63-67 and column 21 lines 31-47 and Fig. 14; *specifically, "one or more usage rights" corresponds to copy count, fee/incentives, time, access, control as shown in Fig. 14, and examples of "one or more conditional values" are given by Stefik, such as limit the number of copies in column 20 line 64, time specification of rights in column 21 lines 31-33).*

As to claims 3, 9, 14 and 18, Stefik teaches the usage rights comprise copying (column 20 lines 63-67).

As to claims 4, 10 and 19, Stefik teaches the conditional values comprise at least one of an absolute value and a relative value that at least one of allow access or restrict access to one or more digital works (column 21 line 31 – column 22 line 3; *specifically, “an absolute value” corresponds to a fixed and predetermined duration in column 21 lines 37-40, 52-54, 59-61, and “a relative value” corresponds to sliding interval usage duration in column 21 lines 40-42, 62 – column 22 line 3).*

As to claim 5, Stefik teaches the one or more conditional rights are associated with one or more digital works (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14).

As to claims 6, 12 and 22, Stefik teaches the digital works comprise audio information, multimedia presentations and video information (column 5 lines 48-54).

As to claim 7, Stefik teaches a method of managing rights comprising (Fig. 14):

- a) determining one or more conditional rights (column 18 lines 9-26 and Fig. 14);
- b) associating the one or more conditional rights with one or more digital works (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14).

As to claim 11, Stefik teaches the one or more conditional rights are associated with one or more portions of information (column 4 lines 15-31 and column 9 line 60 - column 10 line 3 and column 18 lines 9-26 and Figs. 7, 10, 14).

As to claim 13, Stefik teaches a digital rights management language comprising (column 17 lines 49-61 and Fig. 14):

- a) one or more usage rights (column 17 lines 49-61 and column 18 lines 9-26 and Fig. 14);

Art Unit: 3621

b) one or more conditional rights (column 17 lines 49-61 and column 18 lines 9-26 and Fig. 14).

As to claim 15, Stefik teaches the conditional rights comprise at least one trigger that at least one of allows access or restricts access to one or more digital works (column 18 lines 19-24 and column 21 line 31 – column 22 line 3).

As to claim 16, Stefik teaches an information storage media comprising (Fig. 12):

a) information that determines one or more conditional rights (column 18 lines 9-26 and Fig. 14);

b) information that associates the one or more conditional rights with one or more digital works (column 4 lines 15-31 and column 18 lines 9-26 and Fig. 14).

As to claim 20, Stefik teaches the absolute value is at least one of a time and a date (column 21 line 31 – column 22 line 3; *specifically, "the absolute value" corresponds to a fixed and predetermined duration in column 21 lines 37-40, 52-54, 59-61*).

As to claim 21, Stefik teaches the relative value is at least one of based on the status of one or more other usage rights, and one or more events (column 21 line 31 – column 22 line 3; *specifically, "the relative value" corresponds to sliding interval usage duration in column 21 lines 40-42, 62 – column 22 line 3*).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3621

Rhoads et al. (U. S. Patent 6,522,769) discloses reconfiguring a watermark detector.

Mita (JP 2000181868 A) discloses managing document data having access right complying with usage.

Art Unit: 3621

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
January 21, 2004

